

REMARKS

This responds to the Office Action dated August 3, 2004.

No claims are amended, no claims are canceled, and no claims are added; as a result, claims 1-46 remain pending in this application. Applicant respectfully submits that the Office Action Summary appears to include an inaccuracy in stating that claims 1-45 are pending. In particular, claim 46 remains pending.

§102 Rejection of the Claims

Claims 1-3, 5 and 8-40 were rejected under 35 USC § 102(b) as being clearly anticipated by Barreras (U.S. Patent No. 5,807,397).

Applicant respectfully traverses the rejection and submits that *prima facie* anticipation has not been established. In particular, Barreras does not appear to teach or disclose a far field antenna, as recited in claim 1. The Office Action asserts that item 11 of Barreras meets the recited element, however, Applicant is unable to find, in the cited document, support for such an assertion. For example, at column 12, lines 47 *et. seq.* of Barreras, Applicant finds:

Portability is necessary because antenna 17 in within programmer unit 16 must be placed relatively close to implanted stimulator 10 in order to transfer the commands and programming information from antenna 17 to antenna 11.

In addition, Applicant notes the discussion in Barreras at column 18, lines 53 *et. seq.* wherein it is stated "[t]he patch unit 612 is adapted to be placed on the skin of the patient near the implant." Accordingly, Applicant respectfully submits Barreras does not teach or disclose a far field antenna.

The Office Action asserts that Barreras "clearly works according to a 'duty cycle' with modulated and demodulated signals." Applicant respectfully traverses and submits that modulation and demodulation does not amount to operation according to a duty cycle, as recited. The variations in a modulated signal convey information whereas the recited duty cycle is associated with powering and unpowering a circuit. The discussion in Barreras regarding modulated and demodulated signals does not appear to include powering and unpowering. For these and other reasons, it appears that Barreras does not teach or disclose a duty cycle.

As to claim 29, Applicant respectfully traverses the assertion that Barreras discloses a plurality of data receivers comprising antenna 11 and inductor 30. Applicant is unable to find, and the Office Action does not identify, a teaching wherein inductor 30 amounts to a data receiver.

As to claim 36, Applicant is unable to find, in Barreras, a teaching or disclosure of using a wireless far field link, as recited. The Office Action continues to assert that, with regard to Barreras, transmitter electronic module 76 closes the channel after a predetermined time. Applicant disagrees and repeats the request for citation to a specific portion of Barreras in support of the Office Action assertion. Applicant is unable to find a teaching of closing the channel as recited.

For these and other reasons, Applicant respectfully submits that the Office Action has not established *prima facie* anticipation. Reconsideration and allowance of claims 1-3, 5 and 8-40 is respectfully requested.

§103 Rejection of the Claims

Claims 1, 4, 6, 7, 39, 40-42 and 46 were rejected under 35 USC § 103(a) as being unpatentable over Barreras (U.S. Patent No. 5,807,397).

Applicant respectfully traverses the rejection and submits that *prima facie* obviousness has not been established. Applicant is unable to find, in the proposed combination of Barreras and the knowledge of one of skill in the art, a teaching or suggestion of a near field antenna and a far field antenna, as recited in claim 1. In addition, Applicant is unable to find, in the proposed combination, a teaching or suggestion of a duty cycle, as recited in claim 1. Furthermore, the Office Action does not appear to set forth the requisite motivation for combining in the manner proposed.

As to claims 4 and 7, Applicant notes that the Office Action has not set forth the requisite motivation. Pursuant to M.P.E.P. § 2143.01, an assertion concerning the level of skill in the art does not satisfy the requirement of providing the suggestion to combine references. The Office Action does not appear to identify, with specificity, the desirability of making the specific combination as recited in the claim. In particular, the Office Action does not appear to explain

the reasons one of ordinary skill in the art would have been motivated to select and modify Barreras in order to render the claimed invention obvious.

As to claim 6, it is unclear if the Office Action is proposing a combination of Barreras with Cubley or with the knowledge of one of skill in the art. In either case, Applicant submits that Barreras appears to teach away from the proposed combination. In particular, column 15, lines 50-53 of Barreras states that "[t]he entire implant is encased within the titanium casement (not shown) which completely surrounds the implant both electrically and mechanically." Furthermore, if the Office Action is proposing a combination with Cubley, then Applicant submits that *prima facie* obviousness has not been established because, *inter alia*, the requisite motivation has not been identified with specificity.

As to claims 40-42 and 46, it is unclear if the Office Action is proposing a combination of Barreras with White or with the knowledge of one of skill in the art. In either case, Applicant submits that Barreras does not appear to supply motivation for providing far field telemetry with an implantable device. In particular, the cited portion of White does not appear to recite far field telemetry. Furthermore, if the Office Action is proposing a combination with White, then Applicant submits that *prima facie* obviousness has not been established because, *inter alia*, the requisite motivation has not been identified with specificity.

For these and other reasons, Applicant respectfully submits that the Office Action has not established *prima facie* obviousness. Reconsideration and allowance of claims 1, 4, 6, 7, 39, 40-42 and 46 is respectfully requested.

Allowable Subject Matter

Claims 43-45 were objected to as being dependent upon a rejected base claim, but were indicated to be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Applicant respectfully submits that the pending claims are in condition for allowance for at least the reasons presented above. Reconsideration and allowance of claims 43-45 is respectfully requested.

RESPONSE UNDER 37 CFR § 1.116 – EXPEDITED PROCEDURE

Serial Number: 10/025,183

Filing Date: December 19, 2001

Title: AN IMPLANTABLE MEDICAL DEVICE WITH TWO OR MORE TELEMETRY SYSTEMS

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Dkt: 279.391US1

CONCLUSION

Applicant respectfully submits that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney (612) 373-6951 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

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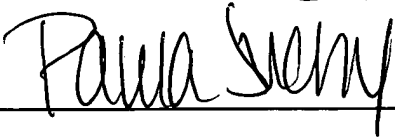
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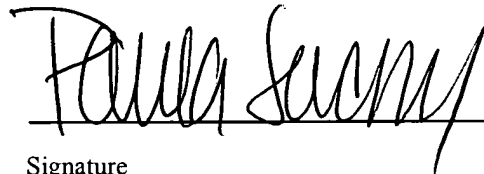
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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Mail Stop RCE, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 3 day of December, 2004.



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